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EXAMINER	
LIN, KENNY S	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/490,553	MORGAN ET AL.	
	Examiner	Art Unit	
	Kenny Lin	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-34 are presented for examination. Claim 35 is canceled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-4, 10-11, 13, 15-16, 19-20, 23, 26, 29, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al (hereinafter King), U.S. Patent 5,895,471, in view of Lagarde et al (hereinafter Lagarde), US 5,721,908.

4. King was cited by the applicant in the IDS. Lagarde was cited in the previous office action.

5. As per claim 1, King taught the invention substantially as claimed including a system for providing Internet-related services in response to a handheld device without requiring the handheld device to itself be Internet-enabled (col.3, lines 51-53, col.4, lines 1-9), comprising:

a. A client module (col.4, lines 47-50) embedded in the handheld device (col.4, lines 47-50, 55-56) to enable the handheld device to directly send a selected stored URL via a local communication link, wherein the URL indicates a desired Internet web page (col.5, lines 19-21, 25-27, col.7, lines 4-16, 20-29, 35-40, col.8, lines 50-53);

b. A receiver that receives the URL sent from the handheld device via the local communication link (col.3, lines 59-61, 63-65, col.6, lines 32-37, 55-61);

c. A web access module coupled to the receiver and to an external Internet via an Internet communication link different from said local communication link to access and retrieve the desired web page from a remote web server via the external Internet (col.1, lines 42-44, 53-55, 60-62, col.4, lines 18-25, col.6, lines 32-40, 55-61).

6. King did not specifically teach a render system being coupled to the web access module and physically separated from said handheld device, to render the retrieved web page in a human discernible format to a user on said render system. Lagarde taught a render system (e.g. IBM Digital Server and output devices including fax, printer, retail, banking, TV and cable) being coupled to the web access module and physically separated from said handheld device (col.15, lines 3-31), to render the retrieved web page in a human discernible format to a user on said render system (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde

because Lagarde's teaching of using a render system separated from handheld device to display web pages enables King's system to use alternative outputs to present the retrieved contents to different output units such as fax, printer, retail or banking installation and video depending on the output type (see Lagarde, col.15, lines 12-22).

7. As per claim 13, King taught the invention substantially as claimed including a system for providing an Internet-related service from a remote Internet-related server via an Internet communication link based on a URL indicated by a handheld device (col.3, lines 51-53, col.4, lines 1-9, 47-50, 55-56), comprising:
   a. A receiver module to receive the URL from the handheld device via a local communication link (col.3, lines 59-61, 63-65, col.5, lines 19-21, 25-27, col.6, lines 32-37, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 50-53);
   b. A web access module to access and retrieve the Internet-related service via the Internet communication link based on the URL (col.1, lines 42-44, 53-55, 60-62, col.4, lines 18-25, col.6, lines 32-37, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 14-29, 50-53).

8. King did not specifically teach a render module, coupled to the web access module and physically separated from the handheld device, to render the retrieved Internet-related service in a human discernible format to a user on the render module. Lagarde taught a render module coupled to the web access module and physically separated from the handheld device (col.15, lines 3-31), to render the retrieved Internet-related service in a

human discernible format to a user on said render module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde because Lagarde's teaching of using a render module separated from handheld device to display web pages enables King's system to use alternative outputs to present the retrieved contents to different output units such as fax, printer, retail or banking installation and video depending on the output type (see Lagarde, col.15, lines 12-22).

9. As per claim 29, King taught the invention substantially as claimed including a mobile system capable of communicating with a gateway module (col.4, lines 28-37), which comprise a web access module to access and retrieve an Internet-related service from a remote Internet-related server via an Internet communication link based on a URL (col.1, lines 42-44, 53-55, 60-62, col.4, lines 18-25, col.6, lines 32-37, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 14-29, 50-53), the mobile system comprising:
    a. A client module (col.4, lines 47-50, 55-56) to enable direct sending of the URL via a communication link to the gateway module for use in the access and retrieval of the Internet-related service (col.1, lines 42-44, 53-55, 60-62, col.4, lines 18-25, col.5, lines 19-21, 25-27, col.6, lines 32-40, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 50-53).

10. King did not specifically teach a render module to receive the retrieved Internet-related service, wherein the gateway module communicates the retrieved Internet-related service

with the rendering module, which is physically separated from the mobile system, and is configured to render the retrieved Internet-related service in a human discernible format to a user on the rendering module. Lagarde taught a render module to receive the retrieved Internet-related service wherein the gateway module communicates the retrieved Internet-related service with the rendering module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19), which is physically separated from the mobile system (col.15, lines 3-31), and is configured to render the retrieved Internet-related service in a human discernible format to a user on the rendering module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde because Lagarde's teaching of using a render module separated from the mobile device to display web pages enables King's system to use alternative outputs to present the retrieved contents to different output units such as fax, printer, retail or banking installation and video depending on the output type (see Lagarde, col.15, lines 12-22).

11. As per claim 32, King taught the invention substantially as claimed including a gateway system capable of receiving a communication including URL via a communication link from a mobile system (col.3, lines 59-61, 63-65, col.5, lines 19-21, 25-27, col.6, lines 32-37, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 50-53), said gateway system comprising:

a. A communication module to receive the communication from mobile system, said communication including a selected URL (col.1, lines 42-44, 53-55, 60-62, col.4, lines 18-25, col.5, lines 19-21, 25-27, col.6, lines 32-40, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 50-53);

b. A web access module to access and retrieve an Internet-related service from a remote Internet-related server via an Internet communication link based on the URL (col.1, lines 42-44, 53-55, 60-62, col.4, lines 18-25, col.6, lines 32-37, 55-61, col.7, lines 4-16, 20-29, 35-40, col.8, lines 14-29, 50-53).

12. King did not specifically teach a render module to receive the retrieved Internet-related service from the web access module, said render module being physically separated from said mobile system and configured to render the retrieved Internet-related service in a human discernible format to a user on the render module. Lagarde taught a render module to receive the retrieved Internet-related service from the web access module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19), said render module being physically separated from said mobile system (col.15, lines 3-31) and configured to render the retrieved Internet-related service in a human discernible format to a user on the render module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde because Lagarde's teaching of using a render module separated from mobile system to access and display Internet-related services enables King's system to use alternative outputs to present the retrieved contents

to different output units such as fax, printer, retail or banking installation and video depending on the output type (see Lagarde, col.15, lines 12-22).

13. As per claim 2, King and Lagarde taught the invention substantially as claimed in claim 1. King further taught that the handheld device fits into a user's palm (e.g. cell phone; col.4, lines 28-37).

14. As per claims 3 and 30, King and Lagarde taught the invention substantially as claimed in claims 1 and 29. King further taught to comprise a memory coupled with the handheld device to store at least on URL, wherein the URL sent is selected from the at least one URL (abstract, col.4, lines 7-15).

15. As per claims 4, 31 and 33, King and Lagarde taught the invention substantially as claimed in claims 1, 30 and 32. King further taught a communication module in the handheld device that receives the URL from a remote site via a second communication link coupled to the communication module (col.3, lines 59-63).

16. As per claims 10-11 and 15-16, King and Lagarde taught the invention substantially as claimed in claims 1 and 13. King further taught that the web access module communicates with the remote web server via the Internet communication link using an open standard communication protocol such as HTTP (col.1, lines 57-62, col.3, lines 42-47, col.6, lines 32-41).

17. As per claim 19, King and Lagarde taught the invention substantially as claimed in claim 1. King further taught wherein the web access module comprises a web browser without a rendering function (col.6, lines 34-41).

18. As per claim 20, King and Lagarde taught the invention substantially as claimed in claim 1. Lagarde further taught that the rendering system is a device-specific rendering system (col.15, lines 12-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde because Lagarde's teaching of using a render system separated from handheld device to display web pages enables King's system to use alternative outputs to present the retrieved contents (see Lagarde, col.1, lines 12-22).

19. As per claims 23, King and Lagarde taught the invention substantially as claimed in claim 1. King further taught that the client module does not have Internet access function and does not include an Internet web browser application program or provide any direct connectivity to the Internet (col.4, lines 28-37).

20. As per claim 26, King and Lagarde taught the invention substantially as claimed in claim 1. King further taught that the URL is in the actual URL form or embedded in a hyperlink (col.1, lines 60-62).

21. Claims 5-9, 12, 14, 17-18, 21-22, 24-25, 27-28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over King and Lagarde as applied to claims 1, 4, 13, 29 and 32-33 above, and further in view of "Official Notice".

22. As per claim 5, King and Lagarde taught the invention substantially as claimed in claim 4. King and Lagarde did not specifically teach that the second communication link is a link to a wireless network. However, Official Notice is taken that it would have been obvious to use link to a wireless network for portable devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the second communication link linking to a wireless network in King and Lagarde's system to provide wireless communication for portable device and reduce the need of physical connection.

23. As per claims 6 and 21-22, King and Lagarde taught the invention substantially as claimed in claims 1. King further taught that the handheld device is selected from a group of devices consisting of: a cellular phone device (col.4, lines 28-37). King and Lagarde did not specifically teach that the handheld device consisting of a pager device, a cellular phone device, a personal organizer device, and a palm pilot device a watch device and an information appliance device. However, many different portable devices can be selected and used in King and Lagarde's system. It would have been a design choice to pick and select all suitable handheld devices usable in the taught invention. Official Notice is taken that the limitations narrowed by these claims are consider

obvious and furthermore a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select any suitable handheld devices as the handheld device taught by King and Lagarde so to enable users of different types of handheld devices to have the ability to access and communicate with the web access module taught in King and Lagarde's system and retrieve web page contents.

24. As per claims 7 and 34, King and Lagarde taught the invention substantially as claimed in claims 1 and 33. King and Lagarde did not specifically teach that, the web access module, and the render system all physically reside within a single enclosure separate from the handheld device. However, Official Notice is taken that it would have been obvious to implement various devices into a single enclosed system to provide multiple functionalities from one system to allow simplified management and administration and also minimize office space. It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings of King and Lagarde and to build the receiver, the web access module and the render system in King and Lagarde's system within a single enclosure separate from the handheld device as a single unit to save space.

25. As per claims 8-9 and 17-18, King and Lagarde taught the invention substantially as claimed in claims 1 and 13. King further taught that the local communication link is a wireless communication link and is selected from a group of communication links consisting of: radio-frequency communication link, an infrared communication link or

other equivalent modes (col.4, lines 28-37). King and Lagarde did not specifically teach that the wireless communication link is selected from a group of communication links consisting of: a microwave communication link, a laser communication link, and combination thereof. However, Official Notice is taken that it would have been obvious for one of ordinary skill in the art to implement different types or combinations of these listed communication links as the wireless communication link as design choices. Furthermore, one of ordinary skill in the art would have been motivated to select types of wireless communication links according to the users' needs or cost of implementation to provide better mobility. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde and further use various types or the combinations of wireless communication link to eliminates the needs for using physical cables and fully advance the mobility of King's handheld devices.

26. As per claims 12, 14 and 27-28, King and Lagarde taught the invention substantially as claimed in claims 1 and 13. Lagarde further taught that the render system further comprises at least one render system selected from a group of systems consisting of: a printer system, a display system, a user interface display system, an audio/video player system, and a Web television system (col.15, lines 3-32). King and Lagarde did not specifically teach that the render system further comprises at least one render system selected from a group of systems consisting of: a projection display system and a combination thereof. However, Official Notice is taken that the limitations narrowed by

these claims are consider obvious and furthermore a matter of design choice. It would have been obvious to select different types or combinations of outputting systems as the rendering system according to different needs. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of King, Lagarde and a use of outputting systems of any type or combination of types as the rendering system to display or print the desired contents to provide the users' different needs (i.e. presentations, reports).

27. As per claims 24, King and Lagarde taught the invention substantially as claimed in claim 1. King and Lagarde did not specifically teach that the client module has Internet access function and include an Internet web browser, but neither the Internet access function nor the Internet web browser are utilized to send the URL via the local communication link. However, Official Notice is taken that it would have been obvious to use desired mobile devices that includes the browsing and Internet access function as the mobile device claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde and further select and use mobile devices that support internet access and browsing features as a design choice to enable various types of mobile device to function as the mobile device in King and Lagarde's system for sending URL rather then limiting the usage to specific types of mobile devices.

28. As per claim 25, King and Lagarde taught the invention substantially as claimed in claim 1. King and Lagarde did not specifically teach wherein only the URL is communicated, and the URL is communicated by sending only a few bytes of data. However, Official Notice is taken that it would have been obvious that URL can be communicated by sending only a few bytes of data since URLs are relatively small in size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to communicate the URL by sending only a few bytes of data since URL is known to be small in size for transmission.

Response to Arguments

29. Applicant's arguments filed 6/9/2005 have been fully considered but they are not persuasive.

30. In the remark, applicant argued that (1) Lagarde is non-analogous art. (2) There is no motivation to combine King and Lagarde. (3) Impermissible Hindsight Reconstruction. (4) The combination of King and Lagarde does not discloses or suggest multiple steps in claim 1 since King does not directly send a selected stored URL wherein the URL indicates a desired Internet web page as recited in claim 1.

31. Examiner traverse the argument that:

As to point (1), in response to applicant's argument that Lagarde is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Lagarde is in the field of applicant's endeavor since Lagarde taught to route URL request responses to control program agent where the control program agent allows alternative output directions for the response. Although Lagarde does not teach to send the request from a handheld device, such limitation is shown in King reference. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to point (2), motivation for combining can be found in Lagarde. Lagarde taught a render module coupled to the web access module and physically separated from the handheld device (col.15, lines 3-31), to render the retrieved Internet-related service in a human discernible format to a user on said render module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde because Lagarde's teaching of using a render module separated from handheld device to display web pages enables King's system to use alternative outputs to present the retrieved contents to different output units such as fax, printer, retail or banking installation and video depending on the output type (see Lagarde, **col.15, lines 12-22**).

As to point (3), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Lagarde taught a render module coupled to the web access module and physically separated from the handheld device (col.15, lines 3-31), to render the retrieved Internet-related service in a human discernible format to a user on said render module (col.12, lines 40-46, 50-52, col.15, lines 3-22, col.18, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of King and Lagarde because Lagarde's teaching of using a render module separated from handheld device to display web pages enables King's system to use alternative outputs to present the retrieved contents to different output units such as fax, printer, retail or banking installation and video depending on the output type (see Lagarde, **col.15, lines 12-22**).

As to point (4), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., directly send a selected stored URL) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Because Applicants have failed to challenge any of the Examiner's "Official Notices" stated in the previous office action in a proper and reasonably manner, they are now considered as admitted prior art. See MPEP 2144.03

Conclusion

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
July 25, 2005

JOHN BOLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100